

REMARKS

Examination on the merits is respectfully requested in light of the following remarks.

1. Status of the Claims

Claims 1-15 stand pending and are subject to a restriction requirement.

2. Restriction Requirement

The Office restricted claims 1-15 in to one of the following groups:

Group I, claims 1-9, "in part", and 10, in full, drawn to methods of producing strains of lipid-producing *Mortierella* fungi comprising the step of suppressing expression of a fatty acid elongase gene; or

Group II, claims 1-9, "in part", and 10, in full, drawn to methods or producing strains of lipid-producing *Mortierella* fungi comprising the step of suppressing expression of a fatty acid desaturase gene; or

Group III, claims 12 and 13, "in part", drawn to breeding kits for producing strains of lipid-producing *Mortierella* fungi comprising the step of suppressing expression of a fatty acid elongase gene; or

Group IV, claims 12 and 13, "in part", drawn to breeding kits for producing strains of lipid-producing *Mortierella* fungi comprising the step of suppressing expression of a fatty acid desaturase gene; or

Group V, claim 14, "in part", drawn to lipid-producing *Mortierella* fungi in which expression of a fatty acid elongase gene is suppressed; or

Group VI, claim 14, "in part", drawn to a lipid producing *Mortierella* fungi in which expression of a fatty acid desaturase gene is suppressed; or

Group VII, claim 15, “in part”, drawn to a method of producing polyunsaturated fatty acids from *Mortierella* fungi in which expression of a fatty acid elongase gene is suppressed; or

Group VIII, claim 15, “in part”, drawn to a method of producing polyunsaturated fatty acids from *Mortierella* fungi in which expression of a fatty acid desaturase gene is suppressed.

4. Election with Traverse

Applicants elect **Group I** (*i.e.*, claims 1-9, in part, and claim 10 in full) with traverse. Applicants traverse the restriction for the following reasons.

(1) Unity was found during review of the international application by the Searching Authority. No explanation of why now there is such a degree of burden to warrant dividing the claims at all, let alone across 8 groups.

(2) When unity is found in the PCT application, there is an *increased burden* above the already “*serious burden*” in evincing why a restriction requirement is necessary. *See e.g.* Anthony Caputa, “Two Be or Not To Be: or Divide and Conquer: or A Case Divided Cannot Stand: Principles in Restriction Practice TC 1600,” presented August 2004 to the Customer Partnership Meeting.

Applicants note that burden went entirely unaddressed, as did the issue of *serious burden* in the instant Restriction Requirement. *See* T. Caputa and M.P.E.P. §§ 803.02, 806.04(a), 806.04(i), 808.01(a) and 808.02. Additionally, as stated by Examiner Caputa, “If the inventions, now being restricted, were searched and examined together in either the current application or a parent, it will be difficult to justify the assertion of burden.” T. Caputa, at page 6. The restriction should be duly reconsidered and withdrawn, because it is improper.

(3) The Office has in effect made a species election by drawing the claims into four (4) groups further divided by whether the fatty acid elongase gene or fatty acid desaturase gene is recited. The Office is using a procedural tool designed to reduce its own administrative burdens as a surrogate to avoid substantive examination of the subject matter that Applicants consider the invention. In fact, this restriction requirement while couched as a restriction requirement, appears to be an improper species election between the elongase and desaturase genes. The

Office does not reduce its own administrative burden properly by shifting onto Applicants the costs of prosecuting a potential myriad of applications directed to overlapping subject matter. The Court of Customs and Patent Appeals held thirty years ago that such a policy contravenes Applicants' statutory right under 35 U.S.C. § 112, second paragraph, to present "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." *See In re Weber*, 580 F.2d 455, 458 (C.C.P.A. 1978).

It is well established that each restriction requirement must be considered on its own merits. *See Id.*; MPEP § 1850. In the present case, rather than consider the merits of the case, the Office has provided no justification relating to *burden of search*.

(4) The Office does not possess unfettered authority to restrict the claims at its own discretion, even when a reference allegedly teaches a technical feature that may destroy unity of invention. *See* MPEP § 1850. Further restriction is justified in this situation only if the "remaining subject matter of each claim differs from that of the others." MPEP § 1850(II), ¶ 4. "[T]he benefit of any doubt is given to the applicant." *Id.* Notably, in this context, the MPEP states that the "decision with respect to unity of invention rests with the International Search Authority [ISA] or the International Preliminary Examining Authority," i.e., *not* the examiner of the corresponding National Stage application. *See* MPEP § 1850(II), ¶ 5.

Clearly, the ISA did not consider the subject matter of the dependent claims to differ sufficiently from that of the others to warrant a restriction requirement. The determination of unity of invention rests with the ISA, who in this case searched all the claims. *See* MPEP § 1850(II), ¶ 5. Properly giving Applicants the benefit of the doubt, the Examiner should rejoin and examine all the claims, or at least rejoin the claims as suggested below. *See* MPEP § 1850(II), ¶ 4.

(5) Applicants submit that the groups should be recombined as follows: Groups 1 and 2 should be rejoined; Groups 3-4 should be rejoined as one group; Groups 5-6 should be rejoined as one group; and Groups 7-8 should be rejoined as one group. No burden is provided as to why the claims have to be further divided along the lines of fatty acid desaturase gene and fatty acid elongase gene. As discussed above, this appears to be an improper species election merely recast as a restriction requirement. It is improper and should be withdrawn.

For all the reasons above, the restriction requirement is improper and should be

withdrawn in its entirety. At the very least, the species restriction should be entirely withdrawn.

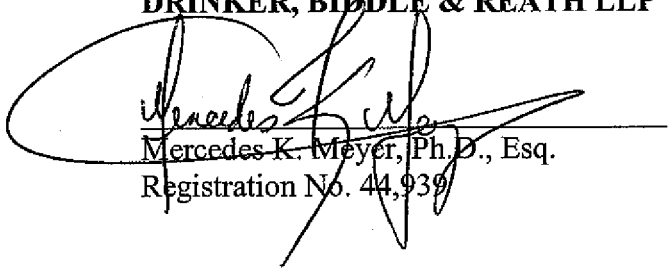
CONCLUSION

If there are any other fees due in connection with the filing of this Preliminary Amendment, please charge the fees to our Deposit Account No. 50-0573. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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